LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
MAY 8 1962
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. **947**

FULLER PRODUCTS CO.,
Respondent,

v.

THE FULLER BRUSH COMPANY,
Petitioner.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

SATTERLEE, BROWNE & DICKERSON,
30 Broad Street,
New York 4, N. Y.
Attorneys for Petitioner.

By: W. MAHLON DICKERSON

Of Counsel:

JOHN H. REILLY, JR.,
New York, New York.

HIBBEN, NOYES & BICKNELL,
Chicago, Illinois.

HAROLD JOHNSON,
Hartford, Connecticut.

Dated: May 2, 1962

INDEX

	PAGE
Citations of Opinions Below	2
Jurisdiction	2
Questions Presented	3
Statutes Involved	3
Statement	3
Reason for Granting the Writ	9

APPENDIX

A. Opinion of the Court of Appeals	1a
B. Opinion of the Trademark Trial and Appeal Board	11a
C. Judgment of the Court of Appeals	15a
D. Order Denying a Petition for a Rehearing	17a
E. Order Staying Issuance of the Mandate of the Court of Appeals	18a
F. Statutes Involved	19a

CITATIONS

Cases

Champion Spark Plug Co. v. Sanders, 1947, 331 U. S. 125, 67 S. Ct. 1136, 91 L.Ed. 1386	12
Chickering, et al. v. Chickering Sons et al., 7 Cir., 1914, 215 F. 490, 494-495	7
Clayton Mark & Co., et al. v. Federal Trade Commission, 1949, 336 U. S. 956, 93 L.Ed. 1110	10

	Page
Clyde Equipment Co. v. Fiorito, 9 Cir., 1926, 16 F.2d 106, 107	10
Commissioner v. Duberstein, 1960, 363 U. S. 278, 292, 4 L.Ed. 2d 1218, 1229	11
Cross v. Pasley, 8 Cir., 1959, 267 F.2d 824	10
Fuller Products Co. v. The Fuller Brush Company, 121 USPQ 327, 49 T.M. 889	3
Hanover Star Milling Co. v. Allen & Wheeler Co., 7 Cir., 1913, 208 F. 513, 517	7
Kellogg Co. v. National Biscuit Co., 1938, 305 U. S. 111, 118, 83 L.Ed. 73, 78	7
Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co., 1942, 316 U. S. 203, 62 S. Ct. 1022, 86 L.Ed. 1381	12
John Morrell & Co. v. Reliable Packing Co., 7 Cir., 1961, 295 F.2d 314, 317	9
Ohlinger v. United States, 9 Cir., 1955, 219 F.2d 310, 311	10
Philco Corp. v. F. & B. Mfg. Co., 7 Cir., 1949, 170 F. 2d 958, 961	7
Sarlshier v. Stoll-Cooper Co., 1900, 170 U. S. 42, 21 S. Ct. 16, 45 L.Ed. 77	12
Travelers Insurance Company v. Dean, 5 Cir., 1956, 228 F.2d 629, 631	10
Triangle Conduit & Cable Co. v. Federal Trade Commission, 7 Cir., 1948, 168 F.2d 175, 179	10
United States v. Formoso, 2 Cir., 1942, 125 F.2d 928, 942-943	10
United States v. Wells, 1931, 283 U. S. 102, 120, 75 L.Ed. 867, 877	11
Wilhartz v. Turco Products, Inc., 7 Cir., 1947, 164 F.2d 731, 733	9

Statutes

	PAGE
U.S.C.:	
Title 15, §1071, 60 Stat. 435, as amended	2
Title 28, §1254(1), 62 Stat. 928	2
Title 28, §2072, 62 Stat. 961, as amended	3
Title 28, §2101(c), 62 Stat. 961, as amended	2
Title 28, §2106, 62 Stat. 963	3
Title 28, Rule 52(a)	3
Title 35, §146	3

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No.

FULLER PRODUCTS CO., *Respondent,*

v.

THE FULLER BRUSH COMPANY, *Petitioner.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

Petitioner, The Fuller Brush Company, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered February 13, 1962, which modified a judgment for respondent entered by the United States District Court for the Northern District of Illinois on January 30, 1961.

The judgment, as modified, directs the cancellation from the Supplemental Register of the United States Patent Office of the petitioner's registration of its mark "Fuller" for vitamins; enjoins the petitioner from using on vitamins or goods of the same descriptive properties its mark "Fuller", or any mark which is confusingly similar to the

respondent's marks "Fuller's" or "Fuller's Quality"; and awards the respondent the right to recover its actual damages resulting from the use by the petitioner of the mark "Fuller" on vitamins.

Citations of Opinions Below

The opinion of the United States Court of Appeals for the Seventh Circuit (February 13, 1961) has not yet been reported officially and is annexed hereto as Appendix "A."[1] The Findings of Fact and Conclusions of Law for the District Court for the Northern District of Illinois, Eastern Division (Vol. II, 632-641), were not officially reported. The opinion of the Trademark Trial and Appeal Board (May 8, 1959) is reported at 121 USPQ 327 and 49 T.M. 889. It is included in Volume II at pages 647-650 of the appendix record below and it is annexed hereto as Appendix "B".

The judgment of the Court of Appeals is annexed hereto as Appendix "C". The order dated April 4, 1962 denying a petition for a rehearing is Appendix "D" annexed hereto. The order dated April 9, 1962 staying the issuance of the mandate of the Court of Appeals for a period of thirty days is Appendix "E" annexed hereto.

Jurisdiction

The jurisdiction of this Court is invoked under 62 Stat. 928, 28 U.S.C. §1254(1) and 62 Stat. 961 as amended, 28 U.S.C. §2101(e).

---

1. References hereinafter to the "Appendix" are to the appendix of this petition; reference to volume and pages, i.e. Vol. I, 40 are to the appendix record below, nine copies of which have been filed in accordance with paragraph 4 of Rule 21 of this Court.

Questions Presented

The questions presented are:

1. May a Court of Appeals determine that the District Court impliedly found an ultimate fact if the circumstantial facts as found by the District Court are not such that the ultimate fact follows from them as a necessary inference?

2. May a successful plaintiff in a suit for infringement of a trademark be awarded damages when it is not demonstrated that the defendant has been guilty of intentional misleading?

Statutes Involved

The statutes involved are: Appeal to courts; review; election of remedies; Commissioner as party, 60 Stat. 435 as amended, 15 U.S.C. 1071; Civil action in case of interference, 60 Stat. 803, 35 U.S.C. 146; Rules of Civil Procedure for District Courts, 62 Stat. 961 as amended, 28 U.S.C. 2072; Rule 52(a) of the Federal Rules of Civil Procedure, Findings by the Court, 28 U.S.C.; Review-miscellaneous provisions, determination, 62 Stat. 963, 28 U.S.C. 2106. They are annexed hereto as Appendix "F".

Statement

This action was instituted, pursuant to the provisions of Title 35 U.S.C. 146, to review the decision of the Trademark Trial and Appeal Board rendered on May 8, 1959, in a Cancellation Proceeding, No. 6992, entitled "Fuller Products Co. v. The Fuller Brush Company", 121 USPQ 327, 49 T. M. 889. That proceeding involved the petitioner's United States Patent Office Registration No. 645,543, dated May 14, 1957, of the mark "Fuller" for use on vitamin food supplement (Vol. II, 647-876). The complaint also alleged trademark infringement and sought an injunction restraining the petitioner from alleged infringement of the respondent's trademark, "Fuller's" upon

vitamin products and an accounting for damages therefor (Vol. I, 4-6).

The Trial Court adopted, without change, the respondent's proposed Findings of Fact and Conclusions of Law and entered judgment reversing the decision of the Trademark Trial and Appeal Board in the aforesaid Cancellation Proceeding and directed the Commissioner of Patents to cancel petitioner's Registration No. 645,543. The petitioner was enjoined from infringing respondent's trademark rights and enjoined from using any trademark including the word "Fuller", or any imitation of respondent's trademark so nearly resembling it as to be likely to cause confusion, on any vitamin product or goods of the same descriptive properties. It was further adjudged that the respondent was entitled to recover from the petitioner the profits, gains and advantages which the petitioner had derived from sales of vitamin food supplement and other vitamin products bearing the word "Fuller" as a source indication. The respondent was also awarded any all damages which it had sustained or will sustain by reason of petitioner's infringement. The Court directed the appointment of a Master to make an account of gains and profits and to assess damages.

On appeal to the United States Court of Appeals for the Seventh Circuit, the judgment of the District Court was affirmed insofar as it directed the cancellation of the petitioner's registration of "Fuller" for vitamins, enjoined future infringement and awarded the respondent the right to recover its actual damages resulting from the use by the petitioner of "Fuller" on vitamins. To the extent that the judgment afforded an accounting for profits it was reversed and the cause was remanded for computation of the respondent's actual damages.

The petitioner is a corporation organized under the laws of the State of Connecticut. It was founded in 1906 by Alfred C. Fuller (Vol. II, 680, Vol. I, 72) who was its first

President and who is presently Chairman of the Board of Directors (Vol. I, 73). It distributes household and personal use merchandise in every state of the Union and in Canada through independent contractors or dealers (Vol. I, 72).

The first product of the petitioner was a twisted-in-wire brush which was manufactured by and sold by Mr. Alfred C. Fuller (Vol. II, 724-725). As early as 1912 the petitioner was marketing 67 different types of brushes (DX 14, Vol. I, 349-364).

Over the years petitioner had diversified and expanded the products of its line and at the time of trial its full line included 95 different brushes; about 46 mops, dusters, brooms and sponges; over 200 cosmetic items and over 78 household products (Vol. I, 73; DX 79*).

The petitioner now manufactures its products in three plants: the main plant is located in Hartford, Connecticut, another in Albany, New York (Vol. I, 74) and one in Canada. It has twenty-six distributing warehouses in the United States, and six in Canada (Vol. I, 74). Ninety two branch offices have been established in this country. There are nineteen branches in Canada (Vol. I, 74).

The petitioner's merchandise can be purchased only from its authorized Dealers, the Fuller Brushmen. At the time of trial there were from 6,200 to 6,300 Fuller Brushmen in the United States and about 1,300 Fuller Brushmen in Canada (Vol. I, 74).

The petitioner had retail sales of over one hundred million dollars for each of the three years preceding the trial: to wit, 1957, 1958, 1959 (Vol. I, 75-76).

The Fuller Brush Company sells four types of vitamin food supplement: a child's capsule, a child's liquid formulation; an adult formulation and a geriatric formulation (Vol. I, 81). The petitioner began to market vitamin food supplement under its trademark "Fuller" in November,

* Appears in a separate exhibit book to be presented to the Court

1955 (Vol. I, 80, DX 71, Vol. II, 597-598). The dollar value of sales of The Fuller Brush Company of vitamins has been the following (Vol. I, 80, 81; DX 72, Vol. II, 599-600):

1955	$ 72,784.29
1956	2,188,922.74
1957	2,830,641.06
1958	3049,256.29
1959	2,767,255.95
Up to Oct. 1960	1,500,842.57

The respondent, a corporation organized under the laws of the State of Illinois, was founded in 1936 by its present President, S. B. Fuller (Vol. I, 21-22). The respondent markets cosmetics, food products and household necessities under its mark "Fuller's Quality" (Vol. I, 22-23). The respondent also sells its merchandise through door to door dealers (Vol. I, 25). The first sale of vitamins by the respondent was made in 1952 (Vol. I, 23) which was less than four years before the petitioner made its first sale of vitamins (Vol. I, 80). The dollar value of the respondent's sales of vitamins has been the following (Vol. I, 53):

1952	$ 5,529.00
1953	12,540.00
1954	12,540.00
1955	12,916.00
1956	13,462.00
1957	16,856.00

Since the notations used by the respondent on its products are a surname, it was necessary for the respondent, in order to have prevailed in this action, to establish that its notations had acquired a secondary meaning. Mere establishment of earlier use does not achieve exclusive rights in a surname. *Chickering, et al. v. Chickering Sons*

et al., 7 Cir., 1914, 213 F. 490, 494-495; *Hanover Star Milling Co. v. Metcalf & Wheeler Co.*, 7 Cir., 1913, 208 F. 513, 517; *Philco Corp. v. Ford R. Mfg. Co.*, 7 Cir., 1949, 170 F. 2d 958, 961; *Coca-Cola Co. v. [illegible]*, 286 U. S. 345, 93 L. Ed. 1102.

It has been held by this Court that in order to establish secondary meaning it must be shown that the primary significance of the term in the minds of the consuming public is not the product but the producer. *Kellogg Co. v. National Biscuit Co.*, 1938, 305 U. S. 111, 118; 83 L. Ed. 73, 78. To acquire secondary meaning in the minds of the buying public, an article of merchandise when shown to a prospective customer must promote the affirmation, "That is the article I want because I know its source", and not the negative inquiry as to "Who makes that article?" In other words, the article must proclaim its identification with its source, and not simply stimulate inquiry about it.

The District Court [illegible] specifically find that the respondent's mark "Pyramid" and "Pyramid Quality" had acquired secondary meaning. The findings make no reference to the significance of the respondent's notations in the minds of the consuming public.

The following [illegible] of Findings of Fact and Conclusions of Law include all references made by the District Court with regard to the use by the respondent of its notations "Fuller's" or "Fuller" Quality":

[illegible]

"1. [illegible] Plaintiff has used its trademark 'Fuller's Quality' and 'Fuller's' upon vitamins since October 1, 1952. The Exhibit [illegible] and continuously since that time [illegible] Plaintiff's use of its mark 'Fuller's' upon vitamins has been substantial, amounting in [illegible] bottles, [illegible] retail dollar sales value; in 1953, [illegible] bottles, $12,540,000;

1954, 8,360 bottles, $12,540.00; 1955, 8,611 bottles, $12,916.00; 1956, 9,641 bottles, $13,462.00 and in 1957, 11,223 bottles, $16,850.00 (R. 80-81)." (Vol. II, 632-633)

"5. Plaintiff's products other than vitamins upon which it has and still uses its mark 'Fullers' or 'Fuller's Quality' with their dates of first use are: Cosmetics and food products (R. 24) 1936 (R. 82) (Pls. Ex. 68) such use was continuous (R. 35-36) and substantial." (Vol. II, 634)

"6. * * * In the meantime, Plaintiff in 1936 (R. 24) (Pls. Ex. 68) (R. 82) entered the cosmetic and food field and commenced using its trademark 'Fuller's Quality' upon cosmetics and food products." (Vol. II, 635)

"7. When Defendant, after discontinuing use of its mark upon cosmetics for 9 or 10 years again entered the field of cosmetics with its 'Fuller' trademark it was subsequent to Plaintiff's 1936 (R. 24) (Pls. Ex. 68) (R. 82) first use of the latter's 'Fuller's Quality' trademark upon cosmetics. * * * Thus Plaintiff has priority of first and continuous use of its mark as a brand not only upon vitamins but also upon cosmetics." (Vol. II, 635-636)

"8. Plaintiff's expansion of its business upon which it used its mark 'Fuller's or Fuller's Quality' from cosmetics and food products to vitamins in 1952 was a natural one and purchasers would expect a manufacturer of vitamins which are a food to emanate from the same source as those food products when the vitamins also bore the same or similar trademark." (Vol. II, 636)

"11. The extension by defendant of its use of the trademark 'Fuller' to vitamins almost four years after the first use of Plaintiff of its 'Fuller's' brand upon vitamins is bound to cause confusion on the part of purchasers as to the source of defendant's vitamins so marked." (Vol. II, 637-638)

Conclusions of Law

"1. Defendant's registration • • • had not been used sufficiently to have then acquired a secondary meaning as applied to the particular goods, to wit: vitamins. • • • The doctrine of 'expansion of trade' is not applicable to a trademark requiring a secondary meaning with respect to the goods to which it is applied as such meaning of necessity is closely associated with the particular goods • • •" (Vol. II, 638)

"4. Defendant by expending greater sums in exploitation of its mark as applied to vitamins after Plaintiff's first use did not thereby acquire any rights in its mark upon vitamins • • •"

"5. Plaintiff as first and continuous user of its mark upon vitamins is entitled to be protected whether or not his use is as great as that of defendant, as widely known or has as great a reputation • • •" (Vol. II, 639)

In none of the foregoing findings or conclusions is there to be found a determination that the primary significance of the terms "Fuller's" or "Fuller's Quality" in the minds of the consuming public is the respondent the Fuller Products Co.

Reason for Granting the Writ

This writ should be granted because the first question the petition presents has received conflicting answers in the Courts of Appeals.

Although on previous occasions the Court of Appeals for the Seventh Circuit has held that the absence of a finding of secondary meaning must be construed as a finding that the words had not acquired such meaning, as in *Wilhartz v. Tarco Products, Inc.*, 7 Cir., 1947, 164 F. 2d 731, 733 and *John Morrell & Co. v. Reliable Packing Co.*, 7 Cir., 1961, 295 F. 2d 314, 317, in this case this

Court of Appeals upheld the judgment of the Trial Court, by deciding that there ran through the findings and conclusions as a whole, the clear implication that the Trial Court did find that the respondent's mark had acquired a secondary meaning as to vitamins.

In the Seventh Circuit it was held in *Triangle Conduit & Cable Co.* v. *Federal Trade Commission*, 7 Cir., 1948, 168 F. 2d 175, 179, that findings are to be construed liberally in support of a judgment or order and whenever from facts found, other facts may be inferred which will support the judgment, such inferences will be deemed to have been drawn. On Writ of Certiorari this judgment was affirmed by an equally divided court under the title of *Clayton Mark & Co., et al.* v. *Federal Trade Commission*, 1949, 336 U. S. 956, 93 L. Ed. 1110.

A Ninth Circuit decision, *Clude Equipment Co.* v. *Fiorito*, 9 Cir., 1926, 16 F. 2d 106, 107, was cited in support of the decision in the *Triangle Conduit & Cable Co.* case (*supra*); and the *Triangle Conduit & Cable Co.* case was followed by the Fifth Circuit in *Travelers Insurance Company* v. *Dapp*, 5 Cir., 1956, 228 F. 2d 629, 631.

These decisions conflict with the emphasis placed on the demands for precise findings in the Second Circuit, *United States* v. *Forness*, 2 Cir., 1942, 125 F. 2d 928, 942-943, and are directly opposed to the decision of the Court of Appeals for the Eighth Circuit in *Cross* v. *Pasloh*, 8 Cir., 1959, 267 F. 2d 824, 827, wherein it is stated that it was not the province of that Court to infer material facts.

In the Ninth Circuit, in *Ohlinger* v. *United States*, 9 Cir., 1955, 219 F. 2d 310, 311, the Court of Appeals refused to look beyond the formal findings of the Trial Court and make reference to the Court's opinion to support a finding of fact.

The petitioner does not suggest that the Trial Court is required to make findings upon all factual issues that are tendered or that arise in a law suit but believes that indispensable facts upon which the controversy depends must be determined. If an ultimate fact follows as a necessary inference from the circumstantial facts which were found by the Trial Court, the petitioner would agree that the Court of Appeals might draw this inference. *United States v. Wells*, 1931, 283 U.S. 102, 120, 75 L.Ed. 867, 877. If, however, the ultimate fact does not follow as a necessary inference from the circumstantial facts which were found, a reviewing court may not properly draw the inference with the assumption that it understands the legal standard with which the trier of fact has approached his task. *Commissioner v. Duberstein*, 1960, 363 U.S. 278, 292, 4 L.Ed. 2nd 1218, 1229.

In the instant case the Court of Appeals based its finding of secondary meaning not upon inference but upon implication. This decision imposes upon an appellant who challenges the factual basis of a judgment of a District Court the obligation of establishing that whatever facts the District Court may be said to have implied are clearly erroneous.

The petitioner believes the effects of the decision of the Court of Appeals to be far reaching. It believes that an important question is presented and that the answers given by the various Circuits are in conflict. It urges this Court to resolve this question by exercising its power of supervision.

The second question presented in this petition was decided by the Court of Appeals in a way which conflicts with applicable decisions of this Court and the petitioner urges that it also be considered. The acts of the petitioner were not shown to be wantonly and intentionally fraudulent. There was no demonstration of intentional

misleading. The award of damages to the respondent conflicts with the principles set forth by this Court in *Champion Spark Plug Co. v. Sanders*, 1947, 331 U. S. 125, 67 S. Ct. 1136, 91 L.Ed. 1386; *Mishawaka Rubber & Woolen Mfg. Co. v. S. S. Kresge Co.*, 1942, 316 U. S. 203, 62 S. Ct. 1022, 86 L.Ed. 1381 and *Sachs Inc. v. Siegel-Cooper Co.*, 1930, 179 U. S. 42, 21 S. Ct. 16, 45 L.Ed. 77.

CONCLUSION

For the foregoing reasons the petition for writ of certiorari should be granted.

Respectfully submitted,

SATTERLEE, BROWNE & DICKERSON,
Attorneys for Petitioner.

By: W. MARTON DICKERSON

Of Counsel:

JOHN H. REILLY, JR.,
New York, New York.

HIBBEN, NOYES & BICKNELL,
Chicago, Illinois.

HAROLD JOHNSON,
Hartford, Connecticut

Dated: May 2, 1962

APPENDIX A

IN THE

United States Court of Appeals

FOR THE SEVENTH CIRCUIT

SEPTEMBER TERM, 1961—JANUARY SESSION, 1962

No. 12513

FULLER PRODUCTS CO., *Plaintiff-Appellee,* THE FULLER BRUSH COMPANY, *Defendant-Appellant.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

February 13, 1962.

Before SCHNACKENBERG, KNOCH and CASTLE, *Circuit Judges.*

KNOCH, *Circuit Judge.* Plaintiff, Fuller Products Co., instituted action in the United States District Court to review the decision of the Trademark Trial and Appeal Board in Cancellation Proceedings brought by Fuller Products Co. against defendant, The Fuller Brush Co.

pany, (121 USPQ 327) which involved U. S. Patent Office Registration dated May 14, 1957, No. 645,643 for vitamin food supplement.

The U. S. Patent Office Supplemental Register shows the trademark involved in the cancellation proceeding consists of "FULLER" in white script letters on a black oval background.

In the District Court, plaintiff also sought injunction restraining The Fuller Brush Company from infringement of plaintiff's own trademark "FULLER'S" on vitamin products, and prayed accounting for damages suffered.

Both plaintiff and defendant sell their products door to door. Each company is named for its founder whose surname was "Fuller."

The Trademark Trial and Appeal Board dismissed the petition for cancellation. In its Opinion, the Board stated that the record showed Fuller Products had used the marks "FULLER'S" and "FULLER'S QUALITY" for vitamins prior to The Fuller Brush Company's use of "FULLER" for vitamins. The Board also held that the marks "FULLER'S" and "FULLER" were, in legal contemplation, identical. However, the Board denied cancellation because it also found (1) that The Fuller Brush Company had been doing business under its trade name "The Fuller Brush Company" since 1911; (2) that it was the record owner of numerous subsisting registrations disclosing its mark "FULLER" for products including brushes, brooms, mops, and the like; furniture, floor and metal polishes; glass, denture and all-purpose cleaners; polishing cloths; shaving cream; bath salts; hand lotion; shampoo; moth repellants and disinfectants; (3) that cosmetics and toiletries which bear names or marks other

that "FULLER," are also labelled with The Fuller Brush Company's trade mark, indicating The Fuller Brush Company to be the distributor, and are sold door-to-door by defendant's "Fuller Brush Men;" (4) that as early as December 13, 1924, The Fuller Brush Company extended its mark to vanity cases containing rouge and face powder; and (5) that The Fuller Brush Company was the prior user of "FULLER" in door-to-door selling of a wide variety of household products, and that use of "FULLER" for vitamins was a natural expansion of such business.

As used on its vitamin containers, The Fuller Brush Company's mark appears as "FULLER" in white script letters enclosed in a darker oval background with the words "Brush Co." in much smaller white block letters also within the oval, immediately below the script "FULLER."

Fuller Products Co. was founded in 1936. It markets cosmetics, food products and household necessities under its mark "FULLER'S" or "FULLER'S QUALITY"; it holds registrations for spices, food flavoring compounds, hair dressings, shaving and skin lotions.

The District Judge found that plaintiff had continuously used its trademark on vitamins in substantial amounts since October, 1952, having previously used it continuously on food products and cosmetics in substantial amounts since 1936, and that its expansion in 1952, from food products and cosmetics to vitamins, was a natural expansion.

In The Fuller Brush Company's application for registration of its mark for vitamins, the first use of the mark for vitamins is alleged to have been on or about January 4, 1956, approximately four years after plaintiff's use. Defendant contends that the registration of its mark for

cosmetics and toilet preparations filed August 15, 1950, had become incontestable when this cause arose, and that The Fuller Brush Company first sold a cosmetic in 1922 in a vanity case containing rouge and face powder.

There was a conflict of evidence as to whether the sale of the cosmetic case had been discontinued and whether or not The Fuller Brush Company had discontinued use of its mark on cosmetics for a period of nine or ten years, as the District Court found it had done. However, the District Judge did not view the use of the mark on cosmetics as controlling in his determination that, having in mind the descriptive properties of The Fuller Brush Company's items, even including cosmetics, the expansion of its business to vitamins was not a natural one. The District Court found that The Fuller Brush Company's mark was a celebrated one only in the field of brushes and related items, that its expansion to the unrelated item of vitamins was bound to cause confusion, and that, expending greater sums in exploitation of its own mark as applied to vitamins, after plaintiff's prior use of its mark as applied to vitamins, could not in itself operate to give defendant any right to use its mark on vitamins.

The District Court found for plaintiff, holding its mark on vitamins to be valid and infringed, reversing the decision of the Trademark Trial and Appeal Board of the United States Patent Office in the Cancellation Proceeding; restraining use of defendant's mark, or any confusingly similar mark, on vitamins or goods of the same descriptive properties; awarding plaintiff the profits, gains and advantages which defendant may have derived from sales of vitamin products using "FULLER" as a source indication, and all damages sustained by plaintiff from the infringement; and referring the matter to a Master to secure accounting of profits and to assess damages.

The Fuller Brush Company appealed to this Court, stating the contested issues to be as follows:

> 1. Has the plaintiff's proof met the statutory requirements for cancellation from the Supplemental Register of the defendant's mark "Fuller" for vitamin food supplement; that is, has the plaintiff demonstrated that the defendant was not entitled to register the mark "Fuller" for vitamin food supplement at the time that the application for registration was made and that the plaintiff is or will be damaged by the registration of said mark? 15 U.S.C. 1092.
>
> 2. Has the plaintiff established that it has exclusive rights in the surname "Fuller" as applied to vitamin food supplement?
>
> 3. Has the use by the defendant of the mark "Fuller" in conjunction with the words "Brush Co." infringed upon plaintiff's alleged common law rights in the marks "Fuller's" and "Fuller's Quality" upon vitamin food supplement?
>
> 4. Is the plaintiff entitled to recover from the defendant any and all damages which plaintiff has sustained by reason of defendant's sale of vitamin food supplement bearing or sold in packages or cartons bearing the word "Fuller"?
>
> 5. Is the plaintiff entitled to recover from the defendant profits, gains and advantages which the defendant has derived, received and made, or which may have accrued to the defendant, from its sale of vitamin food supplement in addition to any and all damages which plaintiff may have sustained?

Both the plaintiff and the defendant are using the true surnames of their founders. Defendant was the first, by many years, to use the name and to make the name famous

for certain of its items. These items included no food products at the time that the plaintiff was organized. From its inception, plaintiff's trademark was applied to food items. Plaintiff was the first to apply its mark to vitamin products. We agree with the District Judge that prior use of a non-distinctive name-mark affords no protection for expansion of trade to goods other than those of the same descriptive properties as the goods with which the mark has become identified by such prior use. *Borg-Warner Corp.* v. *York-Shipley Inc.*, 7 Cir., 1961, 293 F. 2d 88; *Philco Corp.* v. *F. & B. Mfg. Co.*, 7 Cir., 1948, 170 F. 2d 958, 961, cert. den. 336 U. S. 945.

The Fuller Brush Company argues that plaintiff did not establish that its mark acquired a secondary meaning indicating plaintiff as the source of its vitamin products, and that the District Court made no finding of such secondary meaning. The Trial Court did not make a specific finding of a secondary meaning in plaintiff, in so many words. The Trial Judge did expressly negative a secondary meaning in The Fuller Brush Company's mark as to vitamin products. There was a finding of long and substantially exclusive use of plaintiff's mark on food products and a natural expansion to the prior use of its mark for vitamins. The District Court concluded that the defendant by spending greater sums in exploitation of its mark as applied to vitamins, after plaintiff's rights had accrued, could not thereby acquire any rights in its mark on vitamins. We agree with the contentions of the plaintiff that there runs through the findings and conclusions, as a whole, the clear implication that the Trial Court did find that plaintiff's mark had acquired a secondary meaning as to vitamins.

The evidence supports the District Court's conclusion that the marks are confusingly similar, even where defendant has added the words "Brush Co." as these appear in very much smaller letters. Likelihood of confusion does exist here. Damage has been established by a showing that the registration on the Supplemental Register was inconsistent with an equal or superior right of plaintiff to use the same or a similar term.

In *East Tennessee Packing Co. v. Armour & Co.*, 102 USPQ 425 (1954) the Patent Examiner in Chief found that registration on the Supplemental Register was not in order, without regard to whether either party actually had any trademark rights in the registered mark which was the equivalent of one in prior use by the petitioner for cancellation.

In a similar case, *Independent Lock Co. v. Schlage Lock Co.*, 121 USPQ 609 (1959), the Commissioner of Patents held that damage was inferred where registration by Schlage of an outline of a key for key tags was inconsistent with Independent Lock Co.'s right to continue to manufacture similar key blanks and to picture them in catalogs and advertisements.

In *Miller Shoe Co. v. Vaisey-Bristol Shoe Co.*, 116 USPQ 160 (1958) the Commissioner also held that a registration in the Supplemental Register should be cancelled on a showing of priority without regard to superiority of trademark rights.

The Fuller Brush Company would distinguish these cases as not involving a finding, as was made in the instant Cancellation Proceedings by the Trademark Trial and Appeal Board that The Fuller Brush Company's evidence rebutted the presumption that its vitamin product would be confused with that of plaintiff; and that, to the

contrary, the purchasing public would associate Fuller Products Co. vitamins with those of The Fuller Brush Company. That conclusion, however, was based on the Board's finding that The Fuller Brush Company was the prior user of "FULLER" in the field of door-to-door selling of a wide variety of household products and that the use thereof for vitamins was but a natural expansion of such business. That finding was expressly found to be in error by the District Judge, who found, on clear and convincing evidence, that "expansion of trade" by The Fuller Brush Company to vitamins was not a natural one. On the record before us, this Court cannot rule that the District Court's finding was clearly erroneous. Federal Rules of Civil Procedure 52(a). Insofar as the judgment of the District Court directs cancellation of The Fuller Brush Company's registration of its mark for vitamins and enjoins future infringement, the judgment of the District Court must be affirmed.

Plaintiff argues that defendant wilfully extended its mark to wholly different goods, well knowing the long-established prior rights of Fuller Products Co., and that the District Court properly awarded an accounting of both profits and damages. Plaintiff in this regard relies heavily on *Hamilton-Brown Shoe Co. v. Wolf Bros.*, 240 U. S. 251, 36 S. Ct. 269 (1916); *Aladdin Mfg Co. v. Mantle Lamp Co.*, 7 Cir., 1941, 116 F. 2d 708; and *National Lead Co. v. Wolfe*, 9 Cir., 1955, 223 F. 2d 195. Unlike the acts of the infringers in the *Hamilton* and *Aladdin* cases, however, the acts of The Fuller Brush Company in the instant case have not been shown to be wantonly and intentionally fraudulent. In the *National Lead* case, unlike here, intentional mis-leading was demonstrated.

Plaintiff has the burden of proving by competent evidence what its actual damages were. The result may be only approximate, but some reasonable basis of computation must be used. *Eastman Co.* v. *Southern Photo Co.*, 273 U. S. 359, 379 (1927). An accounting for profits, however, is an equitable remedy subject to the principles of equity. 15 U.S.C.A. 1117. On the record before us, we believe that equity dictates recovery of actual damages only. *Berg Warner Corp.* v. *York-Shipley, Inc.*, 7 Cir., 1964, 293 F. 2d ss. 95, 96. To the extent that the judgment affords accounting for profits, it is reversed.

The judgment for plaintiff is modified as indicated above, and the cause is remanded for computation of plaintiff's actual damages.

AFFIRMED IN PART,
REVERSED IN PART,
AND REMANDED.

CASTLE, *Circuit Judge*, dissenting in part.

The record does not support a finding or conclusion that the defendant marked its vitamin food supplement with "Fuller" in an effort to trade on plaintiff's reputation. There is no evidence that plaintiff lost any sales by reason of defendant's use of "Fuller" on its vitamin food supplement; that plaintiff reduced its price because of sales by defendant; that plaintiff's reputation was harmed by defendant's sales; or that plaintiff made expenditures to prevent prospective customers from being misled. In my opinion there is no basis in the record for the award of any damages to plaintiff.

I would reverse the judgment in so far as it decrees that plaintiff is entitled to damages (either actual or measured by defendant's profits) and makes reference to a master for an accounting of profits and assessment of damages. I would affirm the judgment in all other respects.

APPENDIX B

Hearings:

LES

February 4, 1959

Paper No. 31

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

FULLER PRODUCTS CO.

THE FULLER BRUSH COMPANY

Petition to Cancel, No. 6292, Supplemental Registration of a trademark for vitamin food supplement, No. 645,543, issued May 14, 1957, to The Fuller Brush Company.

Melvin A. Brandt for Fuller Products Co.

Satterlee, Browne, Cherbonnier & Dickerson for The Fuller Brush Company.

Before BAILEY, WALDSTREICHER and LEFKOWITZ.

WALDSTREICHER:

A petition has been filed to cancel Supplemental Registration of "FULLER", for a vitamin food supplement, issued to The Fuller Brush Company.[1]

---

(1) Reg. No. 645,543, issued May 14, 1957.

Petitioner is Fuller Products Co., which alleges prior and continuous use of "FULLER'S" for vitamins.

Petitioner is engaged in marketing spices, toiletries, cooking flavors, household items such as polishes and vitamins through its branch stores and independent dealers. Petitioner has, since October, 1952, used the mark "FULLER'S" for vitamins. Between 1952 and 1955, petitioner's gross volume of sales of "FULLER'S" vitamins approximated 48,000. The testimony is silent as to whether that figure represents dollar value, number of bottles or number of vitamin capsules. Petitioner spent approximately $8,000 in 1954, and $9,000 in 1955 in advertising all of the items in its line of goods. There was no testimony as to the amount spent on advertising in any other year nor was there any testimony as to the specific amounts spent in advertising vitamins under the mark "FULLER'S".

Respondent is engaged in marketing brushes, mops, dusters, brooms, sponges, cosmetics and chemical specialties through independent dealers who retail the products to the general public by door to door sales. The retail sales by respondent in 1957 approximated $100,000,000 in value. Respondent advertises its products under the mark "FULLER" and other marks in national consumer magazines and by way of catalogues and circulars and in 1957 expended in excess of $2,000,000 for such advertising. Respondent, in late 1955, began selling vitamin food supplements under the mark "FULLER" and its sales thereof since then have been in excess of $1,000,000 in dollar value. Approximately $150,000 have been expended by respondent in promoting the sale of vitamins under the mark "FULLER".

The mark "FULLERS" and "FULLER" are in legal contemplation identical. The record shows that petitioner has used "FULLERS" [illegible] prior to respondent's first use of "FULLER" [illegible]. The [illegible] or not petitioner has a valid [illegible] of use of its mark [illegible] whether it has right thereto superior to respondent's right to "FULLER" for vitamins.

The record shows that respondent has been doing business under its trade name, The Fuller Brush Company, since at least as early as 1906 and has been selling brushes bearing the mark "FULLER" since then. Respondent is the record owner of a large number of subsisting registrations disclosing the mark "FULLER" for [illegible] December 10, 1951 [illegible] It appears that as early as [illegible] registration of "FULLER" for furniture polish [illegible] floor polishes [illegible] metal polishes [illegible] and for bath salts, hand lotions, shampoo, [illegible] and under various marks [illegible] "FULLER" but which

[illegible]

have labels bearing respondent's trade name and are also sold door to door by the "Fuller Brush Man".

Petitioner, as indicated by its catalogue, in addition to selling its products through its branch stores, sells door to door through its "friendly Fuller dealer". Petitioner in its catalogues promotes, in addition to vitamins, the sale of perfumes, lipsticks, colognes, shampoos, hair preparations, bath preparations, including bath crystals, face powder, face creams, deodorants, sachets, skin lotions, men's toiletries, talcum powder, mouth rinses, furniture polish, an all-purpose cleaner, air fresheners, foot salve and tooth paste. It would appear from the catalogue that, excepting for a few items, all of the above goods are sold under the mark "FULLER'S". It would appear then from the similar practices of the parties that in the field of door to door selling diversification of products is not unusual. In the particular field of door to door selling of a wide variety of household products, respondent is the prior user of "FULLER" and the use thereof for vitamins is but a natural expansion of such business. There can be no doubt that in the field of door to door selling, respondent's mark "FULLER" is a celebrated mark and it seems apparent that the purchasing public would associate "FULLER'S" vitamins with respondent.

Under the circumstances, it is concluded that respondent's rights in "FULLER" for its line of goods including vitamins is superior to petitioner's rights in "FULLER'S" for vitamins.

The petition for cancellation is dismissed.

H. Woodson Hall
A. D. Brooks
S. Leibowitz
Members, Trademark
Trial and Appeal Board

May 8, 1959

APPENDIX C

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Tuesday, February 13, 1962

Before Hon. ELMER J. SCHNACKENBERG, Circuit Judge
Hon. WM. G. KNOCH, Circuit Judge
Hon. LATHAM CASTLE, Circuit Judge

No. 13314

FULLER PRODUCTS CO., *Plaintiff-Appellee*, v. THE FULLER BRUSH COMPANY, *Defendant-Appellant*.	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, AFFIRMED insofar as the said judgment directs cancellation of The Fuller Brush Company's registration of the mark for vitamins and enjoins future infringement, and that the said judgment be REVERSED to the extent that the said judgment affords accounting for profits

The judgment for plaintiff is modified as indicated in the opinion of this Court filed this day, and the cause is REMANDED to the said District Court for computation of plaintiff's actual damages.

It is further ordered that the costs on this appeal be taxed in favor of plaintiff-appellee, Fuller Products Co.

APPENDIX D

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Wednesday, April 4, 1962

Before: Hon. ELMER J. SCHNACKENBERG, Circuit Judge
Hon. WM. G. KNOCH, Circuit Judge
Hon. LATHAM CASTLE, Circuit Judge

No. 13314

FULLER PRODUCTS CO., *Plaintiff-Appellee,* v. THE FULLER BRUSH COMPANY, *Defendant-Appellant.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

IT IS ORDERED by the Court that the petition for a rehearing of this cause be, and the same is hereby DENIED.

APPENDIX E

UNITED STATES COURT OF APPEALS

FOR THE SEVENTH CIRCUIT

Chicago 10, Illinois

Monday, April 9, 1962

Before Hon. WM. G. KNOCH, Circuit Judge

No. 13314

FULLER PRODUCTS CO., *Plaintiff-Appellee.* *v.* THE FULLER BRUSH COMPANY, *Defendant-Appellant.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

On motion of counsel for defendant-appellant.

IT IS ORDERED that the issuance of the mandate of this Court in this cause be, and the same is hereby stayed for a period of thirty (30) days in accordance with the provisions of Rule 28 of the Rules of this Court.

APPENDIX F

STATUTES INVOLVED

15 U.S.C. 1071. *Appeal to courts; review; election of remedies; Commissioner as party.*

"Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancelation proceeding, or any registrant who has filed an affidavit as provided in section 1058 of this title, who is dissatisfied with the decision of the Commissioner or the Trademark Trial and Appeal Board, may appeal to the United States Court of Customs and Patent Appeals or may proceed under sections 145 and 146 of Title 35, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided*, That any party who is satisfied with the decision of the Trademark Trial and Appeal Board shall, upon the filing of an appeal to the Court of Customs and Patent Appeals by any dissatisfied party, have the right to elect to have all further proceedings under section 146 of Title 35, by election as provided in section 141 of Title 35. The Commissioner of Patents shall not be a necessary party to an interpartes proceeding under section 146 of Title 35, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commission shall have the right to intervene in the action. As amended July 19, 1952, c. 950, §3, 66 Stat. 814; Aug. 8, 1958, Pub. L. 85-609, §1(c), 72 Stat. 540."

28 U.S.C. 1254. *Courts of appeals; certiorari; appeal; certified questions.*

"Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

* * *"

28 U.S.C. 2072. *Rules of civil procedure for district courts.*

"The Supreme Court shall have the power to prescribe, by general rules, the forms of process, writs, pleadings, and motions, and the practice and procedure of the district courts of the United States in civil actions.

Such rules shall not abridge, enlarge or modify any substantive right and shall preserve the right of trial by jury as at common law and as declared by the Seventh Amendment of the Constitution.

Such rules shall not take effect until they have been reported to Congress by the Chief Justice at or after the beginning of a regular session thereof but not later than the first day of May, and until the expiration of ninety days after they have been thus reported.

All laws in conflict with such rules shall be of no further force or effect after such rules have taken effect. Nothing in this title, anything therein to the contrary notwithstanding, shall in any way limit, supersede, or repeal any such rules heretofore prescribed by the Supreme Court.

* * *"

28 U.S.C. §2101. *Supreme Court; time for appeal or certiorari; docketing; stay.*

"(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A Justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

28 U.S.C. §2106. *Determination.*

"The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances." June 25, 1948, c. 646, 62 Stat. 965."

28 U.S.C. Rule 52. *Findings by the Court.*

"(a) *Effect.* In all actions tried upon the facts without a jury or with an advisory jury, the Court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given

to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b)." As amended December 27, 1946, effective March 19, 1948."

35 U.S.C. §146: *Civil action in case of interference.*

"Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a

Office Supreme Court, U.S.
FILED
JUN 4 19
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 947

THE FULLER BRUSH COMPANY,
Petitioner,

vs.

FULLER PRODUCTS CO.,
Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION

THEODORE W. MILLER,
209 South La Salle Street,
Chicago 4, Illinois,
Attorney for Respondent.

Of Counsel:
FLEETWOOD M. McCOY,
123 West Madison Street,
Chicago 2, Illinois.

INDEX

	PAGE
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutes Involved	2
Statement of The Case	3
ARGUMENT.	
On First Question Presented	5
Point I—Although Petitioner Presents as its first Question the Propriety of a Court of Appeals Determining that the District Court Impliedly Found an ultimate fact as derived from circumstantial facts which the District Court did expressly find, Petitioner predicates such Question upon the false premise that the ultimate fact impliedly found did not follow as a necessary inference from the circumstantial facts so expressly found.	5
(a) The only reliable facts and evidence thereof from which a secondary meaning may be inferred is long and substantially exclusive use of the trademark upon the particular goods.	6
(b) The trial court by its conclusions as well as its findings indicated that it had in mind the requirement of the marks hereinvolved that they must acquire a secondary meaning in respect to the particular goods while at the same time are limited to goods of the same descriptive properties.	8
(c) The trial court found that Respondent's mark had long and substantially exclusive priority of use upon foods, extended by natural expansion to vitamins, of twenty years at the time Petitioner extended its use of its mark by non-natural expansion to vitamin food supplement.	9

PAGE

(d) The cases cited by petitioner in connection with its first question have no bearing whatsoever upon the necessary findings to support a secondary meaning in personal name trademarks such as herein-volved. 10

On the Second Question Presented, ... 12

Point II—As for the second question presented on whether or not a successful plaintiff in a suit for trademark infringement may be awarded damages in the absence of a finding of intentional misleading, this Court has heretofore held that it can. 12

Point III—The petitioner-defendant in the case at bar did not act innocently. 13

Conclusion 15

Table Of Authorities.

Cases.

Berghoff Brewing Association v. Popel-Giller Company, 273 Fed. 328 10

Champion Spark Plug Co. v. Sanders, et al., 331 U.S. 125 13

General Instruments Corp. v. The U. S. Time Corp., 164 F. 2d 853 11

John Morrell & Co. v. Reliable Packing Co., 7 Cir. 1961, 295 F. 2d. 314, 317 11

Kellogg Co. v. National Biscuit Co., 1938, 305 U.S. 111, 118 3

McLæan v. Fleming, 96 U.S. 245, 252 6

Minnesota Mining and Mfg. Co. v. Tarrant Mfg. Co., 98 USPQ 33, 35 10

Mishawaka Mfg. Co. v. Kresge Co., 316 U.S. 203, 204 12

PAGE

Premier-Pabst Corp. v. Elm City Brewing Co., 9 F. Supp. 754 7

S. C. Johnson & Son Inc. v. Johnson, 1949 2nd Cir., 175 F. 2d. 176, 81 USPQ 509, 512, 513 10

Saxlehner v. Siegel-Cooper Co., 1900, 179 U.S. 42 13

Skinner Mfg. Co. v. General Food Sales Co., 52 Supp. 432 11

United States v. Wells, 1931, 283 U.S. 102, 120 5

Walgreen Drug Stores v. Obear-Nester Glass Co., 113 F. (2d) 956, 963 (CCA8); 46 USPQ 440 8

W. E. Kantenberg Co. v. Ekco Prods. Co., 251 F. 2d. 628, 116 USPQ 417 9

Wilhartz v. Turco Products Inc., 7 Cir. 1947, 164 F. 2d. 731, 733 10

TREATISES.

3 Callmann, Unfair Competition and Trademarks 2d ed.,

p. 1232 11

p. 1237 7

p. 1238 7

p. 1594 9

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961.

No. 947

THE FULLER BRUSH COMPANY,
Petitioner,

vs.

FULLER PRODUCTS CO.,
Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Seventh Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION

This case comes before this Court on petition by The Fuller Brush Company, defendant below, for a writ of certiorari to review the judgment of the United States Court of Appeals for the Seventh Circuit.

OPINIONS BELOW

The opinions below are adequately set forth in the Petition.

JURISDICTION.

The jurisdictional requisites are adequately set forth in the Petition.

QUESTIONS PRESENTED.

The first question presented by the Petition is a question of fact and incorrectly assumes that the particular ultimate fact referred to does not follow as a necessary inference from the circumstantial facts expressly found. Such first question is:

1. May a Court of Appeals determine that the District Court impliedly found an ultimate fact if the circumstantial facts as found by the District Court are not such that the ultimate fact follows from them as a necessary inference?

The second question presented by the Petition is:

2. May a successful plaintiff in a suit for infringement of a trademark be awarded damages when it is not demonstrated that the defendant has been guilty of intentional misleading?

STATUTES INVOLVED.

The statutes involved are adequately set forth in the petition.

STATEMENT OF THE CASE.

Petitioner's "Statement" correctly identifies the parties and the subject matter of the suit. Beyond that, however, petitioner's statement is inadequate. It is so because it intermingles legal arguments and citation of authorities (none of which authorities is referred to later in the petition under the heading "Reasons for Granting the Writ") with fact and even assumes facts contrary to the record and findings below. The findings of fact and conclusions of law are set out below (see Defendant-Appellant's Appendix Vol. II, below, pages 632-641).

In reciting the Findings of Fact and Conclusions of Law by the trial court, the statement in the petition, leaves out pertinent findings and conclusions. These additional findings and conclusions are dealt with in some detail hereinafter by respondent in the argument in this brief and are therefore not specifically set forth here.

There is no dispute in this case as to the requirement of a secondary meaning in a surname as indicated by petitioner in its Statement, on page 6 of the Petition, but the requirements in that respect are not the same as in the case of an overwhelmingly descriptive trademark such as "Shredded Wheat" which was involved in the *Kellogg Co.* v. *National Biscuit Co.*, 1938, 305 U.S. 111, 118, referred to in the Statement, on page 7 of the Petition. In the case of such completely descriptive marks the original meaning is presumed to remain because of the inescapably descriptive character of the mark such that long continued use and even great advertising will not transform them to marks of identification. This is dealt with hereinafter by respondent under the argument Point I(d) of this brief.

The infringement of respondent's food and vitamin trademark by petitioner was wilful and not innocent. Petitioner knew (Defs. Ex. 2, Def's. App., Vol. I, 341) of respondent's prior rights in its "FULLER'S QUALITY" and "FULLER'S" trademarks as applied to foods because it had respondent's 1939 catalogue in its possession showing "FULLER'S Sensational Quality Vitamin B Malted Milk" (Def.'s App., Vol. I, 276) and other foods prior to petitioner's deliberate invasion of the respondent's food (and vitamin) area. The extension of petitioner of the use of its mark to vitamin food supplement was therefore not innocent and any lack of secondary meaning *at the present time* resulting to respondent in the use of its mark specifically applied to vitamins may be ascribed to the deliberate avalanche of use of substantially the same mark on the same goods precipitated by petitioner after the latter's unlawful appropriation. This is dishonest and just as unconscionable as fraud.

ARGUMENT

On First Question Presented

Point I

ALTHOUGH PETITIONER PRESENTS AS ITS FIRST QUESTION, THE PROPRIETY OF A COURT OF APPEALS DETERMINING THAT THE DISTRICT COURT IMPLIEDLY FOUND AN ULTIMATE FACT AS DERIVED FROM CIRCUMSTANTIAL FACTS WHICH THE DISTRICT COURT DID EXPRESSLY FIND, PETITIONER PREDICATES SUCH QUESTION UPON THE FALSE PREMISE THAT THE ULTIMATE FACT IMPLIEDLY FOUND DID NOT FOLLOW AS A NECESSARY INFERENCE FROM THE CIRCUMSTANTIAL FACTS SO EXPRESSLY FOUND.

On page 11, of the petition, Petitioner concedes that:

> "If an ultimate fact follows as a necessary inference from the circumstantial facts which were found by the Trial Court, the petitioner would agree that the Court of Appeals might draw this inference. *United States* v. *Wells*, 1931, 283 U.S. 102, 120, 75 L.Ed. 867, 877."

The ultimate fact which the Court of Appeals determined that the District Court impliedly found from circumstantial facts expressly found was that respondent's trademark "FULLER'S" and "FULLER'S QUALITY" had acquired a secondary meaning indicating respondent as the source of its vitamin products as a necessary inference from the express findings that respondent had a long and substantially exclusive use of its mark on food products and a natural expansion to the prior use of its mark for vitamins.

The pertinent part of the opinion of the Court of Appeals in such determination is as follows (p. 6a of Appendix A attached to brief of petitioner):

> "The Fuller Brush Company argues that plaintiff did not establish that its mark acquired a secondary meaning indicating plaintiff as the source of its vitamin products, and that the District Court made no finding of such secondary meaning. The trial court did not make a specific finding of a secondary meaning in plaintiff, in so many words. The Trial Judge did expressly negative a secondary meaning in The Fuller Brush Company's mark as to vitamin products. There was a finding of long and substantially exclusive use of plaintiff's mark on food products and a natural expansion to the prior use of its mark for vitamins. The District Court concluded that the defendant by spending greater sums in exploitation of its mark as applied to vitamins, after plaintiff's rights had accrued, could not thereby acquire any rights in its mark on vitamins. We agree with the contentions of the plaintiff that there runs through the findings and conclusions, as a whole, the clear implication that the trial court did find that plaintiff's mark had acquired a secondary meaning as to vitamins."

(a) The only reliable facts and evidence thereof from which a secondary meaning may be inferred is long and substantially exclusive use of the trademark upon the particular goods.

(The cases cited by petitioner pertaining to requirements in regard to a secondary meaning have no bearing here as they pertain to trademarks which are presumably incapable of acquiring a secondary meaning because of their overwhelming descriptive character. They are dealt with hereinafter under (d) of this point.)

In *McLean* v. *Fleming*, October 1877, 96 U.S. 245, 254, 255, a finding of long prior use of a personal name mark

upon particular goods was taken as the factual requirement to render it enforceable by injunction (although an accounting was refused but only because of inexcusable laches).

In Callmann, Unfair Competition and Trade-Marks, 2nd Edition, Vol. 3, p. 1237, it is stated:

> "Whether or not a mark has acquired a secondary meaning is a question of fact for the court and is not a proper subject for expert testimony."

and on p. 1238 it further states:

> "It is difficult to prove public reaction by testimony which is sometimes anything but impartial",

citing in footnote 34 cf. *Premier-Pabst Corp.* v. *Elm City Brewing Co.*, 9 F. Supp. 754 (D.C.D. Conn. 1935):

> "To be sure it is not always easy to determine whether in fact the plaintiff has won for himself or his goods any identity which the public recognizes. On this issue, individual members of the purchasing public are frequently called as witnesses and questioned as to their mental reactions. But such testimony, to me at least, is evidence of slight weight for the average individual is seldom a reliable interpreter of his own mental reactions and content." (p. 760).

and further on the same page 1238:

> "A presumption in favor of secondary meaning stems out of a long exclusive use of a trademark, and this has been similarly expressed in the ten-year clause of the Trade Mark Act of 1905 and in Section 2(f) of the Lanham Act"

(Section 2(f) of the Lanham Act permits the Commissioner of Patents to accept as prima facie evidence that the mark has become distinctive as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for five years).

(b) The trial court by its conclusions as well as its findings indicated that it had in mind the requirement of the marks hereinvolved that they must acquire a secondary meaning in respect to the particular goods while at the same time are limited to goods of the same descriptive properties.

In the trial court's Conclusion of Law No. 1 (Def's. App. Vol. II, 638) it held as follows:

> "1. Defendant's registration herein sought to be cancelled, being on the Supplemental Register as a mere surname which had not been used sufficiently to have then acquired a secondary meaning as applied to the particular goods, to wit: vitamins, to become eligible for registration on the Principal Register under Section 2f of the new trademark act, such registration (on the Supplemental Register) constitutes an admission that the mark ('Fuller' in script in the oval) did not at the time of registration constitute a true trade-mark under common law but at most was then at least merely a technical trademark. The doctrine of 'expansion of trade' is not applicable to a trademark requiring a secondary meaning with respect to the goods to which it is applied as such meaning of necessity is closely associated with the particular goods (*Walgreen Drug Stores* v. *Obear-Nester Glass Co.*, 113 F. (2d) 956, 963 (C.C.A. 8) 46 U.S.P.Q. 440)."

Thus the trial court indicated that it had in mind the requirement of the marks hereinvolved that they must acquire a secondary meaning in respect to the particular goods while they are at the same time limited to goods of the same descriptive properties as it further concluded in its Conclusion of Law No. 2 (Def's. App., Vol. II, 639) wherein it held as follows:

> "2. Only a strong (a unique or coined word) trademark is entitled to the benefit of expansion of trade

into non-competing goods and even then it is limited to a reasonable relationship under all the circumstances (3 Callman, Unfair Competition and Trademarks (2 Ed., 1950) at 1594. *W. E. Kautenberg Co. v. Ekco Prods. Co.*, 116 U.S.P.Q. 417). Such is not the case here."

(c) THE TRIAL COURT FOUND IN EFFECT THAT RESPONDENT'S MARK HAD LONG AND SUBSTANTIALLY EXCLUSIVE PRIORITY OF USE UPON FOODS, EXTENDED BY NATURAL EXPANSION TO VITAMINS, OF TWENTY YEARS AT THE TIME PETITIONER EXTENDED ITS USE OF ITS MARK BY NON-NATURAL EXPANSION TO VITAMIN FOOD SUPPLEMENT.

In its Findings Nos. 1, 5 and 8, the trial court found that respondent-plaintiff had used its trademark "FULLER'S QUALITY" and "FULLER'S" since October, 1952, upon vitamins in substantial amounts (Finding No. 1, Def's. App., Vol. II, 632-633); that respondent-plaintiff previous to that had continuously used its said marks upon food products and cosmetics in substantial amount since 1936 (Finding No. 5, Def.'s App., Vol. II, 634); and that respondent-plaintiff's expansion of its business upon which it used its said marks from food products and cosmetics to vitamins in 1952 was a natural one and purchasers would expect a manufacturer of vitamins which are a food to emanate from the same source as those food products when the vitamins also bore the same or similar trademark (Finding No. 8, Def's. App., Vol. II, 636).

The trial court also found (Finding No. 2, Def's. App., Vol. II, 633) that petitioner-defendant, primarily a dispenser of brushes, commenced using its trademark comprising the word "FULLER" in script within an oval and the words "Brush Co." in fine print thereheneath subsequent to November 21, 1955.

The trial court concluded in its Conclusion of Law No. 7 (Def's. App. Vol. II, 640) that "defendant's use of its mark however celebrated upon brushes and like household items prior to plaintiff cannot be deemed to extend to vitamins by any reasonable application of the expansion of trade theory (*Berghoff Brewing Association v. Poppel-Giller Company*, 273 Fed. 328; *Minnesota Mining and Mfg. Co.* v. *Tarrent Mfg. Co.*, 98 USPQ 33, 35 and *S. C. Johnson & Son* v. *Johnson*, 81 USPQ 509)" and further concluded in its Conclusion of Law No. 8 (Def's. App. 640) that since "the mark 'FULLER' in script with the oval, with or without the fine print 'Brush Company' under the word 'FULLER' (or 'FULLER'S QUALITY') of Plaintiff are confusingly similar and the goods (vitamins) are the same, such use by defendant of its said mark is an infringement of Plaintiff's prior rights in its said mark and damage to Plaintiff by defendant's registration and use is presumed."

It is therefore obvious that the trial court considered that respondent-plaintiff's mark had become distinctive of its vitamin goods by long and substantially exclusive twenty years of prior use upon its food products naturally extended to vitamins at the time of petitioner-defendant's wrongful appropriation of its mark upon vitamin food supplement and thus had acquired a secondary meaning as to such products by the only reliable evidence in that respect.

(d) The cases cited by petitioner in connection with its first question have no bearing whatsoever upon the necessary facts and findings to support a secondary meaning in personal name trademarks such as hereinvolved.

For example in *Wilhartz* v. *Turco Products, Inc.*, 7 Cir. 1947, 164 F. 2d. 731, 733, the marks involved were "Auto Shampoo" and "Car Shampoo" which were merely

apt names for the goods and were presumably incapable of acquiring distinctiveness as a source indication regardless of how long or extensively they might be used. In *John Morrell & Co.* v. *Reliable Packing Co.*, 7 Cir. 1961, 295 F. 2d. 314, 317, the mark involved was "E-Z Cut" hams which likewise did little more than define the goods. The latter case cites and follows the "Raisin-Bran" and "Shredded Wheat" cases involving marks of the same character. Thus these cases refer to overwhelmingly descriptive word marks where the original meaning remains predominant because they are comprised of words which are so inescapably descriptive that long continued use and even large expenditures for advertising will not transform such words into marks of identification. See Callmann, Unfair Competition 2nd Ed. Vol. 3, p. 1232:

> "On the other hand, a mark may be so inescapably descriptive that it will defeat all attempts to transform it into a mark of identification and, in such case, even long-continued use and large expenditures will not aid in the search for secondary meaning."

(citing *General Time Instruments Corp.* v. *The United States Time Corp.*, 164 F. 2d. 853 (C.C.A. 2nd 1948) and the "*Raisin Bran*" case, *Skinner Mfg. Co.* v. *General Food Sales Co.*, 52 F. Supp. 432 (D.C. Neb. 1943)).

In conclusion as to the first question presented, it is actually a mere question of fact and there is no conflict between the decisions of the Courts of Appeal because the ultimate fact of secondary meaning in respondent's trademark "FULLER'S" as applied to vitamins impliedly found *necessarily follows* from the long and substantially exclusive use of the mark expressly found upon food products with a natural extension to prior use for vitamins which also was expressly found. That being

so the findings and conclusions of the trial court and the determination of such findings are adequate in respect to the requirements of all of the Courts of Appeal and also the Supreme Court of the United States.

On the Second Question Presented

Point II.

AS FOR THE SECOND QUESTION PRESENTED ON WHETHER OR NOT A SUCCESSFUL PLAINTIFF IN A SUIT FOR TRADEMARK INFRINGEMENT MAY BE AWARDED DAMAGES IN THE ABSENCE OF A FINDING OF INTENTIONAL MISLEADING THIS COURT HAS HERETOFORE HELD THAT IT CAN.

In *Mishawaka Mfg. Co.* v. *Kresge Co.*, 316 U.S. 203, 204, in a case involving no intentional misleading or actual deception but mere reasonable likelihood "that some purchasers might have been induced by the purchaser's belief that he was obtaining petitioner's product" (p. 204), this Court reversed not because there was an award of profits and damages but because the award of profits put the burden on the plaintiff instead of defendant by limiting the profits to sales "to purchasers who were induced to buy because they believed the heels to be those of plaintiff and which sales plaintiff would otherwise have made" (p. 204). This Court in reference thereto said (p. 207):

> "The decree in effect requires the petitioner to prove by a procession of witnesses, that when they bought heels from the infringer they had a clear well-focused consciousness that they were buying the petitioner's heels and that otherwise they would not have bought them. But the shoe is on the other foot."

This Court further awarded damages in addition to profits saying (p. 208):

> "If the petitioner suffered damages beyond the loss of profits the decree should provide for the assessment of such damages."

Thus this Court has held that where the equities require it even in a mere infringement case involving no fraud or intentional misleading the award of both profits and damages is proper.

The other cases cited by petitioner do not apply here. In *Champion Spark Plug Co.* v. *Sanders*, 1947, 331 U.S. 125, the infringement was merely technical in that the accused spark plugs sold by the defendant were of the plaintiff's original manufacture and bore the plaintiff's original trademark but were repaired and resold by the defendant.

In *Saxlehner* v. *Siegel-Cooper Co.*, 1900, 179 U.S. 42, the defendant acted innocently.

Point III.

THE PETITIONER-DEFENDANT IN THE CASE AT BAR DID NOT ACT INNOCENTLY.

Petitioner knew of respondent's use of its trademark "FULLER'S" and "Fuller's Quality" upon foods and cosmetics as far back as January 9, 1942, because it had in its possession respondent's 1939 catalogue (Pl's. Ex. 68, Def's. App. Vol. I, 273-292) illustrating such use upon food products, including on page 4 thereof "FULLER'S SENSATIONAL VITAMIN B MALTED MILK" and other foods and a full line of cosmetics because petitioner on May 9, 1946 wrote a letter (Def. Ex. 2, Def's. App. Vol. I, 3'1) to respondent protesting the fact that the front cover of said catalogue had a picture of a salesman which feature petitioner claimed to have copyrighted. The picture was quite different from that on petitioner's 1936 catalogue (Def. Ex. 1, Def's. App. Vol. I, 293).

At the time that respondent commenced using its trademarks "FULLER'S" and "FULLER'S QUALITY" it

was essentially in connection with a foods and cosmetics business (Pls. Ex. 68, Def's. App. Vol. I, 273-292) whereas petitioner's business in connection with which it used its "FULLER" trademark at that time was essentially a brush business including a few items which are used with brushes such as combs etc. (Def. Ex. 1, Def's. App. Vol. I, pp. 293-339).

Petitioner's extension of the use of its mark "FULLER" to food items (vitamins) in November 1955 or 1956 was therefore *well knowing of respondent's prior rights* and the damage to respondent's food and vitamin business was obvious when one considers the dilution of good will resulting from the tremendous infringing usage by petitioner which it portrays on page 6 of its petition. Petitioner there depicts its dollar value of sales of its "FULLER" vitamins from the last month of 1955 up to October, 1960 as amounting to a total of $12,409,702.70 which dwarfs the dollar value of sales of respondent. According to the might makes right thinking of petitioner this comparison is supposed to be its sword and shield. All this tremendous usage of petitioner's mark upon vitamins according to petitioner, even though it may have diluted respondent's secondary meaning to the point of extinction, it is supposed to also wipe out respondent's long prior rights including the latter's 20 year prior rights of its mark upon food products. Assuming petitioner may have been laboring under a delusion in respect to its rights as a result of such thinking, it would not make it an innocent infringer to the extent that it should not account for its damages or even profits where damages may not otherwise be proven under circumstances such as here.

CONCLUSION

For the reasons set forth above, we submit that the petitioner for a writ of certiorari should be denied.

Respectfully submitted,

THEODORE W. MILLER
209 South La Salle Street,
Chicago 4, Illinois
Attorney for Respondent.

Of Counsel:
FLEETWOOD M. MCCOY,
123 West Madison Street,
Chicago 2, Illinois.